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Docket No. MPS-411XC1
Serial No. 09/334,163Remarks

Claims 1-6, 10-11, 16, and 18-27 are pending in the application. Claims 1, 6, and 16 have been amended above to insert the word "and" in front of reference to corn line LS288 as suggested by the Examiner at page 4 of the latest Office Action, for which suggestion Applicant hereby expresses his gratitude. Claim 23 is also amended above to clarify what is claimed is a method for initiating a corn line breeding program. Upon entry of these amendments, claims 1-6, 10-11, 16, and 18-27 will remain pending in the application.

Applicant respectfully traverses the §112, first paragraph, "written description" rejection of claims 23, 26, and 27 set forth at pages 2-3 of the Office Action. The Office Action implies that for Applicant to be able to claim F1 hybrid seed and plants having the claimed inbred lines as parents, Applicant would have to have an actual reduction to practice prior to the filing of the application. This is clearly not the law. The correct standard in determining whether sufficient written description exists is whether one of ordinary skill in the art would understand the inventor to be in possession of what is claimed. Clearly, once a true breeding line has been obtained, the inventor is effectively "in possession of" F1 offspring by virtue of the plethora of corn varieties which are publicly available, and to which the new strain can readily be mated to produce F1 seed and offspring. One does not have to actually produce the F1 offspring to be recognized as being in effective possession of the F1 seed and offspring. Claim 23 has been amended above to claim a method of initiating a corn plant breeding program, again something which the ordinary artisan would readily recognize the inventor to be in possession of once he had obtained the claimed inbred corn lines. Further, Applicant respectfully disagrees with the Office Action's assertion that "it would be impossible to determine whether or not a plant of unknown parentage is covered by the claims." Although this sounds more like a §112, second paragraph rejection, Applicant notes that molecular characterization of F1 hybrid plants would be routine for those of ordinary skill in the art, and would readily lead to a determination of whether any of the claimed inbreds were parents of the F1 tested. Accordingly, those skilled in the art would readily be able to determine whether the F1 hybrid falls in the scope of the subject claims. Reconsideration is respectfully requested.

Next, claims 1, 6, 16, and 23 stand rejected under 35 USC §112, second paragraph, as indefinite for reasons set forth at pages 3-4 of the Office Action. Applicant believes that this rejection has been obviated by virtue of the above amendments to the claims, and requests reconsideration in view thereof.

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Finally, claims 26 and 27 stand rejected under §102(b)/§103(a) as set forth at page 5 of the Office Action. Applicant respectfully traverses. As noted above, the ordinary artisan could readily determine whether an F1 hybrid had as one of its parents a plant according to claim 6, i.e., LS0417, LS1498, or LS288, by routine molecular characterization of the F1 hybrid. Because none of the plants according to claim 6 existed until this invention, and because the ordinary artisan could routinely determine whether any F1 seed or plant had as one of its parents a plant according to claim 6, the ordinary artisan would be able to distinguish the claimed F1 seed and plants from any disclosed in the prior art. Therefore, the subject matter of claims 26 and 27 could not be anticipated or rendered obvious by the prior art. Reconsideration is respectfully requested.

Applicant is pleased to note the Examiner's indication at page 6 of the Office Action that claims 1-6, 10-11, 16, and 18-25 are free of the prior art.

In view of the foregoing, Applicant believes that all claims as currently pending are in condition for allowance and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

Applicants invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,


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Attachments: Petition and Fee for Extension of Time; Request for Continuing Examination.

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